

Remarks:

Applicants have studied the Advisory Action dated January 31, 2008, and has amended the claims to distinctively claim the subject matter of the invention. Support for the claims is found within the specification and the drawings. It is submitted that the application is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Allowable Subject Matter:

The Applicants wish to thank the Examiner for finding claims 35 to 42 allowable.

In the following, the Applicants respond to the Examiner's rejection under Section 112 and objections as to introduction of new matter.

§112 Rejection(s):

The Examiner rejects the pending claims as failing to comply with written description and enablement requirements, under 112 par. 1 and as being indefinite under 112 par. 2 because allegedly no support is provided for the toy having "growing limbs".

The Applicants maintain that the Examiner grounds of rejection have no basis in case law or the MPEP, as provided in further detail below. However, for the purpose of advancing prosecution the claim language has been removed from the claims by way of the present amendment. Support for the amended language is provided through out the specification and the figures.

In support of the Applicants' position that the inventor was in the possession of the claimed subject matter (i.e., a toy with movable or growing limbs), the Examiner is referred to page 2, line 2 of the application as filed, wherein the Applicants disclose a "Robo-Dog" which is irrefutably a toy with limbs that move or grow.

Respectfully, the Examiner's contention that the lack of specific phrase or wording in the specification is proof of lack of knowledge (i.e., possession) of well-known concepts or embodiments in the related art is without merit, in this particular case. The Examiner is kindly

reminded that the claim language should be interpreted in light of the specification and common knowledge (i.e., “common sense”) available to person of ordinary skill, otherwise the application would be an endless construction of common details which are not necessary for the full understanding of the invention (see MPEP 2173.05).

Common sense would allow a person of ordinary skill reading the application as filed to determine that a toy, in general, has a body with body parts. The Examiner would agree that this is nothing out of the ordinary. And to contend otherwise, would result in the extra-ordinary as one would not expect a toy not to have a body or a body part. The Examiner contends that he deems the invention to be related to a virtual toy. However, there is no reason for the Examiner to interject such limitation into the claims. There is no portion in the specification that either explicitly or implicitly limits the invention to a virtual toy (i.e., a toy displayed on a screen).

Referring to the figures and the specification, it is clear that the invention can be directed to a physical toy, (i.e., a learning and growing toy mentioned on page 6 of the specification as filed) that can be *connected* to a computer, and not necessarily a virtual toy that appears on a computer screen. Respectfully, referring to pages 9, 12 and 15 specifically, and in light of the specification in its entirety, in several instances the specification supports the notion that the toy may grow both intellectually and physically. Again, no portion of the specification has an express limitation that the physical growth is not to apply to the physical limbs of the toy, nor is there any support for the Examiner’s contention that the growth is virtual in nature.

Respectfully, one of ordinary skill would understand that a toy can physically grow in size by way of a mechanical instrument incorporated in one of the toy’s physical limbs, elements or attributes. Particularly, referring to FIG. 5, a motor 100-1 is disclosed which supports a mechanical instrument within the toy that may be used to move or grow a limb. As such, the Examiner’s argument that the egg-shaped drawing in FIG. 11 should be interpreted narrowly to exclude any physical growth in the toy, and to limit it to a virtual character on a screen, is counter intuitive to the nature and spirit of the disclosure, particularly in light of the fact that (1) the specification never refers to virtual growth per se and (2) the specification refers in multiple section to “physical” growth of the toy.

For the above reasons, the Examiner’s limited and self-serving interpretation of depiction in FIG. 11 is not adequate support for the Examiner’s argument that the “physical” growth disclosed in the specification is virtual in nature. Further, there is no reason provided by the Examiner why the egg-shaped drawing in FIG. 11 which clearly illustrates a body and several limbs is inadequate to support the claim language. Respectfully, over simplification of the material disclosed in the specification by the Examiner in a direction away from what is recited in the claims is inappropriate and insufficient grounds for rejection under 112, particularly due to lack of any language in the specification, or case law or statutory provision to support the Examiner’s position.

The Examiner is reminded that §112, first paragraph, requires for the specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP 2163, Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563, 19 USPQ2d at 1116. Furthermore, support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the Applicants were in possession of the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) (emphasis added). Claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See In re Oda, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Contrary to the Examiner’s position, the test under Section 112 is not whether all possible details are included in the specification or the claim, but whether a person of ordinary skill would understand, based on common sense or common knowledge, how the invention works, if he read the specification. Over the past decades, there have been many examples of toys with moving and growing limbs and parts, or toys that imitate emotion and desire available in the market. As an example of toys that display desire or imitate emotion, talking dolls, or barking plush toys are common in any toy store. As an example of toys that grow in size, any toy with a telescopic arm or leg or other body part would suffice. As such, the Examiner is respectfully requested to reconsider and withdraw the 112 grounds of rejection.

The Examiner also contends that claim language related to a living organism's emotions and desires is vague. The Applicants have removed the related language from the claims, without prejudice. It is respectfully submitted, however, that a person of ordinary skill would understand that information associated with emotions of a living organism comprises information about whether the living organism is happy, sad, hungry, excited, friendly, hostile, etc. The claim language should be interpreted in light of the specification and common knowledge (i.e., "common sense") available to a person of ordinary skill; otherwise, the Application would be an endless construction of common details which are not necessary for the full understanding of the invention (see MPEP 2173.05).

For the above reasons, it is submitted that the 112 rejection is now moot. If the Examiner continues to reject the pending claims under 112, the Examiner is requested to recite case law or a statute in support of his rejections, particularly the latter rejection pertaining to the allegation of claim language being vague simply because the claim languages recites emotions and desires that may vary per subject or in time. Respectfully, the fact that claim language covers multiple or a variety of possibilities does not render it vague. To the contrary, the use of broad and encompassing language is deemed appropriate so long as it is supported by the specification.

Particularly, there is no support in the MPEP for rejecting claim language as vague, just because the claim language covers a variety of possibilities. It would be improper for the Examiner to continue rejecting the claims as vague when no case law or statutory support is provided to sanction the Examiner's position; especially where the claim language as read and understood by a person of ordinary skill in the art, is not vague but supports different possibilities.

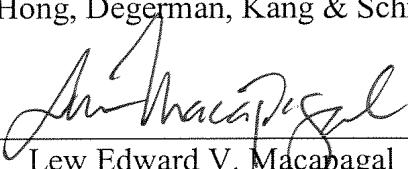
If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623 2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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By:



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